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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,368	09/10/2003	Virgil G. Atkins	23190.00	3319
37833	7590	10/19/2005		
LITMAN LAW OFFICES, LTD PO BOX 15035 CRYSTAL CITY STATION ARLINGTON, VA 22215			EXAMINER TALBOT, MICHAEL	
			ART UNIT	PAPER NUMBER
			3722	

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/658,368

Applicant(s)

ATKINS, VIRGIL G.

Examiner

Michael W. Talbot

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 4-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>09/10/03</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-3, drawn to a Carpet Cutting Tool, classified in class 408, subclass 204.
 - II. Claims 4-10, drawn to a Method of Repairing a Damage Section of Carpet, using a Carpet Cutting Tool, classified in class 156, subclass 94.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as apparatus and process of using apparatus. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the carpet cutting tool can be used to cut materials other than carpet, such as paper, cloth or metal sheet layers/panels.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During telephone conversation with Mr. Dolph H. Torrence on 05 October 2005, a provisional election was made with traverse to prosecute the invention of group 1, claims 1-3. Claims 4-10 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention.

Specification

2. The disclosure is objected to because of the following informalities:

Refer to page 11, lines 5 and 6, the phrase "under the carpet one all sides of the opening" should be changed to read --under the carpet on all sides of the opening--

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Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Uffman '407. Uffman '407 shows in Figures 1-4 a cutting tool (10,18) comprising a hollow cylinder (10) with an open end (cutter 18 end) having a circumference and a sharp, uniform, smooth cutting edge (31) and a closed end with means for attaching (20) to a power drill (11,12). Uffman '407 shows the cutting edge adapted for cutting circular segments of material (13). Uffman '407 shows the "means for attaching" comprising a irremovable shaft (20) fixed to the closed end and being adapted for being gripped by a chuck (11) of a power drill (12).

With regards to the "means for attaching" recited in claim 1, this limitation meets the three-prong test per MPEP 2181 and thereby invokes 35 U.S.C. 112, 6th paragraph. Hall '519 shows the attachment of the cutter tool with a power drill being performed through the shank (4). This member is capable of performing the identical function, "attaching", in substantially the same way (shaft for engagement with chuck of power drill) and produce substantially the same result (secure connection) as the arbor shaft (30).

With regards to claim 1, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Hall '519. Hall '519 shows in Figures 1-3 a cutting tool (1) comprising a hollow cylinder (2) with an open

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end (col. 2, lines 50-55) having a circumference and a sharp, uniform, smooth cutting edge (11) and a closed end (3) with means for attaching (4) to a power drill (col. 2, lines 44-49). Hall '519 shows the cutting edge adapted for cutting circular segments of material (shown by Fig. 3 circular profile). Hall '519 shows the "means for attaching" comprising a irremovable shaft (4) fixed to the closed end and being adapted for being gripped by a chuck (11) of a power drill (col. 2, lines 44-49).

With regards to the "means for attaching" recited in claim 1, this limitation meets the three-prong test per MPEP 2181 and thereby invokes 35 U.S.C. 112, 6th paragraph. Hall '519 shows the attachment of the cutter tool with a power drill being performed through the shank (4). This member is capable of performing the identical function, "attaching", in substantially the same way (shaft for engagement with chuck of power drill) and produce substantially the same result (secure connection) as the arbor shaft (30).

With regards to claim 1, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Mick '464. Mick '464 shows in Figures 2-5 a cutting tool (A) comprising a hollow cylinder (10,11) with an open end (cutting end) having a circumference and a sharp, uniform, smooth cutting edge (16) and a closed end (solid shank end) with means for attaching to a power drill (page 2, lines 8-17). Mick '464 shows the cutting edge adapted for cutting circular segments (page 1, lines 8-14) of material (22,26).

With regards to the "means for attaching" recited in claim 1, this limitation meets the three-prong test per MPEP 2181 and thereby invokes 35 U.S.C. 112, 6th paragraph. Mick '464 shows the attachment of the cutter tool with a power drill being performed through the shank

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(10). This member is capable of performing the identical function, "attaching", in substantially the same way (shaft for engagement with chuck of power drill) and produce substantially the same result (secure connection) as the arbor shaft (30).

With regards to claim 1, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Uffman '407 in view of Sutton et al. '403. Uffman '407 lacks the closed end having an aperture for receipt of an arbor shaft removably attached by a fastener. Sutton et al. '403 shows in Figures 1-4 a closed end of annular cutter (2) having an aperture (42) for receiving an arbor shaft (8) removable attached by a fastener (56) for retaining the cylinder on the arbor shaft. Alternatively in Figures 6-8, Sutton et al. '403 shows a closed end of annular cutter (2) having an aperture (42') for receiving an arbor shaft (8) removable attached by a male/female (77,76) connector means (24) for retaining the cylinder on the arbor shaft. In view of this teaching of Sutton et al. '403, it would have been obvious to one of ordinary skill in the art to replace the permanently fixed shaft of Uffman '407 with a removable shaft of Sutton et al. '403 to provide a quick engagement/disengagement means for interchanging annular cutter heads for cutting various holes sizes and to replace worn cutter heads.

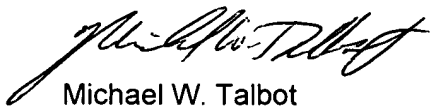
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5. Any inquiry concerning the content of this communication from the examiner should be directed to Michael W. Talbot, whose telephone number is 571-272-4481. The examiner's office hours are typically 8:30am until 5:00pm, Monday through Friday. The examiner's supervisor, Mr. Boyer D. Ashley, may be reached at 571-272-4502.

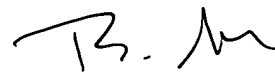
In order to reduce pendency and avoid potential delays, group 3720 is encouraging FAXing of responses to Office Actions directly into the Group at FAX number 571-273-8300.

This practice may be used for filling papers not requiring a fee. It may also be used for filing papers, which require a fee, by applicants who authorize charges to a USPTO deposit account.

Please identify Examiner Michael W. Talbot of Art Unit 3722 at the top of your cover sheet.



Michael W. Talbot
Examiner
Art Unit 3722
5 October 2005



BOYER D. ASHLEY
PRIMARY EXAMINER